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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/002,560	11/01/2001	Randy S. Bay	56911US002	3716
32692	7590	04/12/2004	EXAMINER	
3M INNOVATIVE PROPERTIES COMPANY			EASHOO, MARK	
PO BOX 33427			ART UNIT	PAPER NUMBER
ST. PAUL, MN 55133-3427			1732	

DATE MAILED: 04/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/002,560	BAY ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Mark Eashoo, Ph.D.	1732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM  
 THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on the papers filed 02-02-04.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) 13-22 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-11 and 23-40 is/are rejected.
- 7) Claim(s) 12 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>4/02, 2/03</u> .	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____

## DETAILED ACTION

### *Election/Restrictions*

Applicant's election with traverse of claim group I, claims 1-12 and 23-40, filed 20-FEB-2004 is acknowledged. The traversal is on the ground(s) that there is no serious burden on the Office to examine both claim groups. This is not found persuasive because the structural specifics of the instant apparatus are not required for a search and examination of claims directed a process of making an article, because apparatus limitation are only given weight according to how they affect method in manipulative sense. *Ex parte Pfeiffer*, 135 USPQ 31 (BdPatApp&Int, 1961). Conversely, the specific steps of how a structural limitation is used or may affect a process (ie. intended use) has little patentable weight in examination of an apparatus. *In re Finsterwalder*, 168 USPQ 530 (CCPA, 1971); *In re Casey*, 152 USPQ 285.

The requirement is still deemed proper and is therefore made FINAL.

### *Information Disclosure Statement*

The information disclosure statements filed 15-APR-2002 and 03-FEB-2003 comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609. Accordingly, they have been placed in the application file and the information referred to therein has been considered as to the merits.

### *Claim Objections*

Claims 7, 8, 30, 31, 38, and 39 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

In each of the claims, only a single apparatus limitation has been added to further define a claim directed to a process of making an article. As currently written, each added apparatus limitation does not affect the process in a manipulative sense but rather appears to be a mere use of the recited structure. To be entitled to patentable weight in method claims, recited structural

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limitations must affect method in manipulative sense and not amount to mere claiming of a use of a particular structure. *Ex parte Pfeiffer*, 135 USPQ 31 (BdPatApp&Int, 1961).

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 7, 8, 30, 31, 38, and 39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In each of the claims, only a single apparatus limitation has been added to further define a claim directed to a process of making an article. As currently written, each added apparatus limitation does not affect the process in a manipulative sense but rather appears to be a mere use of the recited structure. To be entitled to patentable weight in method claims, recited structural limitations must affect method in manipulative sense and not amount to mere claiming of a use of a particular structure. *Ex parte Pfeiffer*, 135 USPQ 31 (BdPatApp&Int, 1961). Each of the claims is indefinite because it cannot be clearly ascertained how the process is different, in a stepwise manner or in the manipulative sense, from the claim from which each depends.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Claims 1-6 and 10 are rejected under 35 U.S.C. 102(e) as being anticipated by Braunschweig et al. (US Pat. 6,197,076).

Regarding claims 1 and 2: Braunschweig et al. teaches a method of capping a stem web, comprising: passing a stem web through a first nip (I3:35-62 and Fig. 3); cooling the web (I3:40-41 and Fig. 3); passing a stem web through a second nip (I3:35-62 and Fig. 3); and a D:d ratio of 2:1 (7:37-52).

Regarding claim 3: Braunschweig et al. teaches a line speed of 76 m/minute (I3:41).

Regarding claim 4: Braunschweig et al. teaches a cooled roll (I3:40-41 and Fig. 3).

Regarding claims 5 and 6: Braunschweig et al. teaches a first nip between a first heated roll and a cooled roll and a second nip between a second heated roll and the cooled roll (I3:35-62 and Fig. 3).

Regarding claim 10: Braunschweig et al. teaches a web contacting a cooled roll for about 50% of its circumference (Fig. 3).

Claims 23, 24, and 26-29 are rejected under 35 U.S.C. 102(e) as being anticipated by Braunschweig et al. (US Pat. 6,197,076).

Regarding claims 23 and 24: Braunschweig et al. teaches a method of capping a stem web, comprising: passing a stem web through a first nip (I3:35-62 and Fig. 3); cooling the web (I3:40-41 and Fig. 3); passing a stem web through a second nip (I3:35-62 and Fig. 3); a D:d ratio of 2:1 (7:37-52); and applying an abrasive layer or mineral coating (I3:47-I4:10).

Regarding claim 26: Braunschweig et al. teaches embedding abrasive particles, partially curing, applying a size coating, and curing of the size coat (I3:47-I4:10 and Fig. 1).

Regarding claim 27: Braunschweig et al. teaches a cooled roll (I3:40-41 and Fig. 3).

Regarding claims 28 and 29: Braunschweig et al. teaches a first nip between a first heated roll and a cooled roll and a second nip between a second heated roll and the cooled roll (I3:35-62 and Fig. 3).

Claims 35-37 are rejected under 35 U.S.C. 102(e) as being anticipated by Braunschweig et al. (US Pat. 6,197,076).

Regarding claim 34: Braunschweig et al. teaches a method of capping a stem web, comprising: passing a stem web through a first nip (I3:35-62 and Fig. 3); cooling the web (I3:40-41 and Fig. 3); passing a stem web through a second nip (I3:35-62 and Fig. 3); and a D:d ratio of 2:1 (7:37-52).

Regarding claim 35: Braunschweig et al. teaches a cooled roll (I3:40-41 and Fig. 3).

Regarding claims 36 and 37: Braunschweig et al. teaches a first nip between a first heated roll and a cooled roll and a second nip between a second heated roll and the cooled roll (I3:35-62 and Fig. 3).

Regarding claim 40: The examiner recognizes that all of the claimed effects and physical properties are not positively stated by Braunschweig et al., for example, Braunschweig et al. does not teach a specific modulus for the a stem web. However, Braunschweig et al. teaches all of the instantly claimed ingredients, process steps, and process conditions. Therefore, the instantly claimed effects and physical properties would inherently be achieved by carrying out the disclosed process of Braunschweig et al. If it is applicant's position that this would not be the case: 1) evidence would need to be presented to support applicant's position; and 2) it would be the examiner's position that the application contains inadequate disclosure in that there is no teaching as to how to obtain the claimed properties and effects by carrying out only the instantly claimed steps.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein

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were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Braunschweig et al. (US Pat. 6,197,076).

Braunschweig et al. teaches the basic claimed process as set forth above. Braunschweig et al. teaches rolls of equivalent diameter (13:35-40). However, added apparatus limitation of one roll having a diameter of 30% greater than another does not affect the process in a manipulative sense but rather appears to be a mere use of the recited structure. To be entitled to patentable weight in method claims, recited structural limitations must affect method in manipulative sense and not amount to mere claiming of a use of a particular structure. *Ex parte Pfeiffer*, 135 USPQ 31 (BdPatApp&Int, 1961). As such the limitation appears to be a mere and obvious matter of design choice depending upon the capital equipment on hand in order to keep new costs to a minimum.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Braunschweig et al. (US Pat. 6,197,076) as applied to claims 1-6 and 10 above and further view of Chesley et al. (US Pat. 6,579,162).

Braunschweig et al. teaches the basic claimed process as set forth above. Braunschweig et al. does not teach a cooling fluid directed onto the surface of the web. However, Chesley et al. teaches a cooling fluid directed onto the surface of the web (8:55-65). Braunschweig et al. and Chesley et al. are combinable because they are from the same field of endeavor, namely, forming hook fastener products. At the time of invention a person having ordinary skill in the art would have found it obvious to have used a cooling fluid directed onto the surface of the web, as taught by Chesley et al., in the process of Braunschweig et al., and would have been motivated to do so because Chesley suggests that such cooling means is an equivalent and alternative means of cooling a capped stem web.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Braunschweig et al. (US Pat. 6,197,076) in view of Harvey et al. (US Pat. 6,660,121).

Braunschweig et al. teaches the basic claimed process as set forth above. Braunschweig et al. does not teach a control system for the rolls. Nonetheless, Harvey et al. teaches a roll controlling/adjusting system comprising sensors at each end of a roll (2:35-42, 4:15-24, and Figs.). Braunschweig et al. and Harvey et al. are combinable because they are from the same field of endeavor, namely, forming hook fastener products. At the time of invention a person having ordinary skill in the art would have found it obvious to have used a roll controlling/adjusting system comprising sensors at each end of a roll, as taught by Harvey et al., in the process of Braunschweig et al., and would have been motivated to do so because Harvey suggests that such control system aides in the application of uniform roll pressure across the roll thereby increase uniformity of the end product.

Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Braunschweig et al. (US Pat. 6,197,076) as applied to claims 23, 24, and 26-29 above and further view of Chesley et al. (US Pat. 6,579,162).

Braunschweig et al. teaches the basic claimed process as set forth above. Braunschweig et al. does not teach applying an abrasive layer prior to capping a stem web. However, Chesley et al. teach applying an abrasive layer prior to capping a stem web. (9:48-10:9). Braunschweig et al. and Chesley et al. are combinable because they are from the same field of endeavor, namely, forming hook fastener products. At the time of invention a person having ordinary skill in the art would have found it obvious to applied an abrasive layer prior to capping a stem web., as taught by Chesley et al., in the process of Braunschweig et al., and would have been motivated to do so because Chesley suggests that application of an abrasive layer is an equivalent and alternative means of forming the abrasive containing hook fastener product.

Claims 30 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Braunschweig et al. (US Pat. 6,197,076).

Braunschweig et al. teaches the basic claimed process as set forth above. Braunschweig et al. teaches rolls of equivalent diameter (13:35-40). However, added apparatus limitation of one roll having a diameter of 30% greater than another does not affect the process in a manipulative sense but rather appears to be a mere use of the recited structure. To be entitled to patentable weight in method claims, recited structural limitations must affect method in manipulative sense and not amount to mere claiming of a use of

a particular structure. *Ex parte Pfeiffer*, 135 USPQ 31 (BdPatApp&Int, 1961). As such the limitation appears to be a mere and obvious matter of design choice depending upon the capital equipment on hand in order to keep new costs to a minimum.

Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Braunschweig et al. (US Pat. 6,197,076) as applied to claims 23, 24, and 26-29 above and further view of Chesley et al. (US Pat. 6,579,162).

Braunschweig et al. teaches the basic claimed process as set forth above. Braunschweig et al. does not teach a cooling fluid directed onto the surface of the web. However, Chesley et al. teaches a cooling fluid directed onto the surface of the web (8:55-65). Braunschweig et al. and Chesley et al. are combinable because they are from the same field of endeavor, namely, forming hook fastener products. At the time of invention a person having ordinary skill in the art would have found it obvious to have used a cooling fluid directed onto the surface of the web, as taught by Chesley et al., in the process of Braunschweig et al., and would have been motivated to do so because Chesley suggests that such cooling means is an equivalent and alternative means of cooling a capped stem web.

Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Braunschweig et al. (US Pat. 6,197,076) as applied to claims 23, 24, and 26-29 above and further in view of Harvey et al. (US Pat. 6,660,121).

Braunschweig et al. teaches the basic claimed process as set forth above. Braunschweig et al. does not teach a control system for the rolls. Nonetheless, Harvey et al. teaches a roll controlling/adjusting system comprising sensors at each end of a roll (2:35-42, 4:15-24, and Figs.). Braunschweig et al. and Harvey et al. are combinable because they are from the same field of endeavor, namely, forming hook fastener products. At the time of invention a person having ordinary skill in the art would have found it obvious to have used a roll controlling/adjusting system comprising sensors at each end of a roll, as taught by Harvey et al., in the process of Braunschweig et al., and would have been motivated to do so because Harvey suggests that such control system aides in the application of uniform roll pressure across the roll thereby increase uniformity of the end product.

Claims 38 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Braunschweig et al. (US Pat. 6,197,076).

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Braunschweig et al. teaches the basic claimed process as set forth above. Braunschweig et al. teaches rolls of equivalent diameter (13:35-40). However, added apparatus limitation of one roll having a diameter of 30% greater than another does not affect the process in a manipulative sense but rather appears to be a mere use of the recited structure. To be entitled to patentable weight in method claims, recited structural limitations must affect method in manipulative sense and not amount to mere claiming of a use of a particular structure. *Ex parte Pfeiffer*, 135 USPQ 31 (BdPatApp&Int, 1961). As such the limitation appears to be a mere and obvious matter of design choice depending upon the capital equipment on hand in order to keep new costs to a minimum.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Buzzell et al. '642 and '670, Tuma, Poulakis, and Provost et al. all teach the basic state of the art.

#### ***Allowable Subject Matter***

Claim 12 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: The prior art of record does not teach or render obvious forming and capping a web, for a hook fastener, having a width of 1 meter or greater. It is noted that Buzzell et al. '642 teaches that conventional fastener materials "have been less than one or two feet in width".

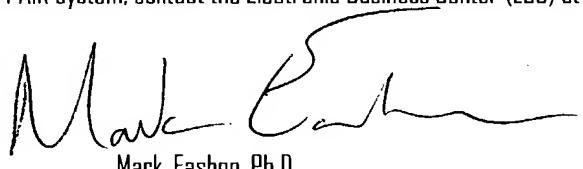
#### ***Correspondence***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Eashoo, Ph.D. whose telephone number is (571) 272-1197. The examiner can normally be reached on 7am-3pm EST, Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Colaianni can be reached on (571) 272-1196. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Mark Eashoo, Ph.D.  
Primary Examiner  
Art Unit 1732

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